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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,858	08/20/2001	Friedrich Altmann		5615

7590 11/18/2002

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EXAMINER

SULLIVAN, DANIEL M

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 11/18/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,858

Applicant(s)

ALTMANN, FRIEDRICH

Examiner

Daniel M Sullivan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-107 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 35-107 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 35-48, 53, 54, 66-69 and 93-107, drawn to: a DNA molecule comprising a sequence selected from the group consisting of the sequence according to SEQ ID NO:1, a sequence which is at least 50% homologous with the sequence according to SEQ ID NO:1 or a sequence which hybridizes with the sequence according to SEQ ID NO:1 under stringent conditions; a vector, peptide nucleic acid and host cell comprising said DNA molecule; method of making said DNA molecule; and method of using said DNA molecule to clone a GlcNAc- α 1,3-fucosyl transferase.

Group II, claim(s) 49-52, 62-65, 76-79 and 83-86, drawn to a vector comprising SEQ ID NO:1 in antisense orientation, a ribozyme and host cell comprising and method of using said host cell comprising SEQ ID NO:1 in an antisense orientation.

Group III, claim(s) 55-61, 70-75, 80, 81, 82 and 87-89 drawn to a method of preparing a recombinant host wherein GlcNAc- α 1,3-fucosyl transferase is suppressed comprising inserting a DNA molecule according to Group I.

Group IV, claim(s) 90-92, drawn to a method of selecting DNA molecules coding for a GlcNAc- α 1,3-fucosyl transferase comprising hybridization with the DNA molecules of Group I.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The Groups are united in that they are drawn to compositions comprising DNA molecules homologous to or complementary to the sequence set forth as SEQ ID NO:1 and methods of using said compositions. However, DNA molecules comprising sequences homologous to the sequence set forth in the instant application as SEQ ID NO:1, and claimed in Group I, were known in the art at the time the application was filed (see especially EMBL Database ID: AQ158899, EMBL Database ID: AQ328306, and EMBL Database ID: B67847 cited in the International Search Report mailed 19 July 2000). As the product claims do not represent a

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contribution over the prior art, the claims lack a special technical feature that is the same as or that corresponds to a special technical feature of the other claimed inventions. Thus, there is no special technical feature linking the recited groups as would be necessary to fulfill the requirement for unity of invention.

The products of Group II are distinct from the products of Group I because the antisense constructs of Group II are not disclosed as capable of use together with the constructs of Group I and have different functions and effects (i.e. antisense or ribozyme mediated inhibition of gene expression) than the products of Group I (i.e. heterologous expression or overexpression of GlcNAc- α 1,3-fucosyl transferase or suppression of GlcNAc- α 1,3-fucosyl transferase expression by gene knockout).

The methods of Group III are distinct from the methods of Group IV as Group III is directed to methods of inhibiting expression of GlcNAc- α 1,3-fucosyl transferase expression and Group IV is directed to methods of selecting DNA molecules coding for GlcNAc- α 1,3-fucosyl transferase comprising a hybridization assay. The methods are not disclosed as capable of use together and have different modes of operation, functions and effects as one comprises inserting the DNA into a cell and the other comprises *in vitro* hybridization.

The products of Group I are related to the methods of Groups III-IV as product and method of using. The inventions are distinct because the products of Group I can be used in each of the distinct methods comprised in Groups III-IV.

The products of Group II are not related to the methods of Groups III-IV, as neither method is disclosed as comprising the antisense or ribozyme construct to which the claims of Group II are directed.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 703-305-4448.

The examiner can normally be reached on Monday through Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached on 703-305-1998. The fax phone numbers for the

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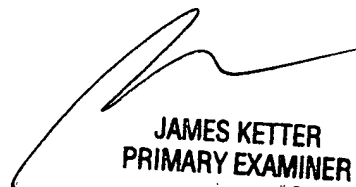
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organization where this application or proceeding is assigned are 703-746-9105 for regular communications and 703-746-9105 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

dms

November 12, 2002



**JAMES KETTER
PRIMARY EXAMINER**